

Application No.: 09/216,206

Art Unit: 3622

REMARKS / ARGUMENTS

This is a reply to the Office Action mailed on December 22, 2010. Applicant respectfully requests reconsideration of the outstanding rejections in view of the following remarks and arguments.

Applicant is the Assignee of the present application and is prosecuting the present application under 37 C.F.R. § 3.71. A statement under 37 C.F.R. § 3.73(b) is submitted herewith.

I. Status of claims

Claims 49, 50, 62 – 96, 112 – 148, 164 – 200, and 216 – 227, 231 – 269, 271 and 272 are currently pending in the present application.

Claims 49, 50, 62 – 96, 112 – 148, 164 – 200, 216 – 227 and 231 – 269, stand rejected. Claims 271 and 272 are subject to a restriction requirement and are withdrawn from consideration.

II. Priority / Specification

In the Office Action, the Examiner asserted that this application is not entitled to the priority date of U.S. Patent Application No. 08/787,979, filed on January 22, 1997 (the “979 application”). Specifically, the Examiner held that the application does not meet the prerequisite requirements for claiming the benefit of the earlier priority date in accordance with 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(1).

The Examiner thus refused to enter the substitute specifications filed on January 22, 2004 and March 5, 2007, because the amendments to the specification included, *inter alia*, a priority claim to the ‘979 application.

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On April 17, 2011, Applicant filed a petition pursuant to 37 C.F.R. §§ 1.127 and 1.181, requesting that the Examiner's refusal to recognize the priority claim be reversed. The petition further requested entry of the substitute specifications.

On April 27, 2011, a decision on the petition was entered, granting the petition in part. The Director reversed the Examiner's holding regarding priority and found that the application is entitled to claim priority to the '979 application. The Director, however, returned the application to the Examiner for a determination that the rephrased paragraphs in the substitute specifications are not considered new matter and are permissible under 37 C.F.R. § 1.57(f).

Accordingly, Applicant respectfully requests acknowledgement of the priority claim in view the decision on the petition. In addition, Applicant respectfully requests that the substitute specifications be determined not to include new matter.

III. Claim Rejections

A. Rejection under 35 U.S.C. § 102(b) and 103(a) over Yager

The Examiner rejected all of the pending claims under 35 U.S.C. § 102(b) and/or § 103(a) as being unpatentable over Yager.

In accordance with the decision on the petition cited above, this application is entitled to the benefit of the filing date of the '979 application, filed January 22, 1997. Further, each of the pending claims is supported by the specification of the '979 application in the manner set forth in 35 U.S.C. § 112, ¶1. Accordingly, the Yager reference, dated December 1997, cannot be considered prior art.

B. Rejection under 35 U.S.C. § 102(b) and § 103(a) over Goldhaber et al.

The Examiner rejected all of the pending claims under 35 U.S.C. § 102(b) and/or § 103(a) as being unpatentable over U.S. Patent No. 5,794,210 issued to Goldhaber et al. ("Goldhaber").

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Goldhaber describes a system and method that compensates users for viewing advertisements on their computers. According to Goldhaber's invention, when a user logs on to his personal homepage, the user is shown a list of preselected advertisements that are targeted to the user's interest. Goldhaber Col. 7 lines 27-32. A virtual "price tag" is associated with each advertisement that indicates the amount the user will receive for viewing the advertisement. Each time the user selects an advertisement for further viewing, the user is compensated in the form of digital cash according to the "price tag" associated with the advertisement. The digital cash is credited to the user's account. Goldhaber Fig. 3, Col. 10, lines 39-66.

In pertinence, Goldhaber states the following:

Upon logging on to her customized home page, Cynthia would be presented with a list of ads that she may elect to view. The ads would be preselected for her on the basis of a personal profile questionnaire that she has completed plus automatic tracking of her previous Internet usage. For example, today's list might contain ads for medium-price hotels in Mazatlan (where Cynthia is planning a vacation), a do-it-yourself telescope kit (a possibility for her son's upcoming birthday), San Francisco Forty-Niner football tickets (she's a fan), new nonfat organic dessert items (she's on a diet), and heavy equipment for earth moving (she is part-owner of a construction company). (emphasis added.)

Goldhaber at Col. 7, lines 27-35.

Goldhaber present users with **preselected** advertisements together with associated price tags. Thus unlike the claimed invention, Goldhaber does not disclose a real-time bidding and selection mechanism for Internet advertising.

In the *Response to Arguments* section of the Office Action, the Examiner cites Goldhaber at col. 4 lines 47-63, where Goldhaber describes an auction mechanism through which advertisers can competitively bid for a viewer's attention. Yet, unlike the pending claims, Goldhaber fails to disclose a real-time bidding and selecting mechanism.

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The Examiner cites Goldhaber at col. 4, line 58-60, where it is taught that the system may offer bidding without the viewer's knowledge. In response, Applicant respectfully points out that while bidding may occur without the viewer's knowledge, Goldhaber does not teach that the bidding occurs in real time. To the contrary, Goldhaber teaches that the ads are "preselected" – clearly suggesting that the bidding and selection does not occur in real time. In contrast, each of the pending claims unambiguously require that the bidding and selection mechanism occur in real-time – that is the time it takes for web content to load in response to a viewer's request for the content. Accordingly, for the foregoing reasons, Applicant respectfully traverses the rejection over Goldhaber.

IV. Related Applications

The present application is related to application nos. 10/655,549, 09/372,416, 11/675,429, 11/933,122, 11/933,080 and 11/926,939. Applicant trusts that the Examiner will review, to the extent deemed necessary, the contents of the file wrappers for these applications to determine the applicability of their contents to the present application, including the rejections and office actions.

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CONCLUSION

In view of the foregoing remarks and arguments, reconsideration of the outstanding rejections is respectfully requested. Should an interview be helpful in advancing the application, Applicant respectfully requests that the Examiner contact the undersigned to schedule an interview.

Dated: June 22, 2011

Respectfully submitted,
BEH Investments LLC *

Signature: /Benzion A. Wachsman/

Name: Benzion A. Wachsman

Title: General Manager

Tel.: (718) 928-2213

Fax: (718) 504-9671

* A statement pursuant to 3.73(b) is attached.

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